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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,349	08/16/2001	Byung Ju Dan	2080-3-33	2633

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EXAMINER	
BEKERMAN, MICHAEL	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,349	DAN ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-8,10-13,15,16,18-23,25-30 and 35-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-8,10-13,15,16,18-23,25-30 and 35-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 August 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 6/26/2006.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: ST7. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. The amendment filed 6/26/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material

which is not supported by the original disclosure is as follows: Claim 28 recites the limitation "the desire information is randomly generated by the toy". This random generation was not disclosed in the original filing.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. Claim 27 is objected to because of the following informalities: This claim, after being amended, has become exactly the same as claim 26, which both depend from claim 19. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While it is easy to see how a virtual character could grow, it is unclear as to how the toy can physically grow and this lacks an enabling explanation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Referring to claim 1, this claim recites the limitation of storing advertising banners. It is unclear where these advertising banners come from. Are they included in the product information?

Referring to claim 5, this claim recites the limitation analyzing/processing. It is unclear if the limitation refers to "analyzing", "processing", "analyzing and processing", or "analyzing or processing".

Referring to claim 5, this claim recites the limitation "the goods information of video or voice". There is insufficient antecedent basis for this limitation in the claim.

Referring to claim 19, this claim recites the limitation "the advertising banner goods". There is insufficient antecedent basis for this limitation in the claim.

Referring to claim 35, this claim recites the limitation "associated with desires of a living organism". This is indefinite and unclear. What does a living organism desire? Not all living organisms desire the same thing.

Referring to claim 39, this claim recites the limitation "associated with emotions of a living organism". This is indefinite and unclear. What emotions does a living organism have? Does an single-celled organism have emotions?

Referring to claims 1-34, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The claims appear to be written to treat hardware and software as living subject matter. Applicant needs to specify what structure and steps are virtual or simulated, and which structure and steps exist in the real world. Some examples are as follows:

- Does the toy physically grow, or does the virtual character simulated by the toy grow? (Claim 1)
- A toy does not learn, it may gather and store information. While the virtual character may grow, it does not appear that the toy grows. (Claims 15, 19, and 38)
- How does a non-living toy output living emotion? (Claim 39)

These were only a few examples. Applicant must go through the claims and clearly specify the different between "real world" and simulation. All claims must be addressed and corrected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 1, 2, 4-8, 10, 12, 13, 15, 16, 19-23, 25-30, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (U.S. Patent No. 5,971,855) in view of Bloomfield (U.S. Pub No. 2002/0028704).**

Regarding claims 1, 2, 7, 13, 15, 19, 25-29, and 35-40, Ng teaches a virtual character that conveys desire information through health points (Column 5, Lines 53-55) and the desire information may be satisfied by the user giving the virtual character what it wants (Column 7, Lines 35-38). One of the options is to feed the virtual character (Column 6, Lines 37-39). Ng also teaches connecting the virtual character to a computer and then to a website (Column 2, Lines 38-41), and downloading upgrades as well as restoring, growing, and changing the character's health (Column 3, Lines 59-63, and Column 4, Lines 1-3). Desire information is outputted to the web server when a request is made to restore the character's health. Ng does not specify that the character is nourished by product and advertising information. Bloomfield teaches a virtual character that is nourished and grows based on being fed data information from the Internet (Paragraph 0105). Bloomfield also teaches that it is well known for virtual characters to collect data by clicking through a banner advertisement (Paragraph 0003). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replenish the health of Ng's virtual character with online advertisements, as taught by Bloomfield. This would provide a more realistic approach to feeding the character while providing a greater number of click-throughs for advertiser banners. The web server of Ng stores scores of users' virtual characters (Column 2, Lines 47-51), and this reads on storing the respective effect on the adaptive toy.

Regarding claims 4 and 20, neither Ng nor Bloomfield teach the updating of advertisement databases. It would have been obvious to one having ordinary skill in the

art at the time the invention was made that advertisements would need to be updated continuously. This would give more advertisers a chance to advertise.

Regarding claim 5 and 10, Ng teaches the virtual character as outputting desire information (Column 5, Lines 53-55) and being healed by information downloaded from the web server (Column 4, Lines 1-3). Once the virtual character is connected to a computer through a cable(Column 2, Lines 38-41), a keyboard as an input device becomes inherent in the system. Ng does not specify that the character is nourished by product and advertising information. Bloomfield teaches a virtual character that is nourished and grows based on being fed data information from the Internet (Paragraph 0105). Bloomfield also teaches that it is well known for virtual characters to collect data by clicking through a banner advertisement (Paragraph 0003). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replenish the health of Ng's virtual character with online advertisements, as taught by Bloomfield. This would provide a more realistic approach to feeding the character while providing a greater number of click-throughs for advertiser banners.

Regarding claims 6, 8, 16, and 30, Ng teaches the virtual character as outputting sound effects for eating (Column 6, Lines 20-22).

Regarding claim 12, Ng teaches the web server as storing a character's name (user name) and a character's score (information about the toy) (Column 2, Lines 47-51).

Regarding claims 21-23, these claims introduce the specific data content of the advertising banner database, it could be argued that neither Ng or Bloomfield do not

teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see In re Gulack, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of advertising data content. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

7. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (U.S. Patent No. 5,971,855) in view of Bloomfield (U.S. Pub No. 2002/0028704), and further in view of Tanaka (U.S. Patent No. 6,120,379).**

Regarding claim 11, Neither Ng nor Bloomfield teaches a barcode reader or CCD camera as being attached to the toy. Tanaka teaches a toy comprising a CCD camera (Figures 1 and Column 8, Line 26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach a camera to the toy. This would provide more enjoyment for the user. The claim language "for receiving names or barcodes of goods directly by the user" is intended use. The structure recited in claim 11 merely calls for a CCD camera or a barcode reader to be attached to the adaptive toy.

ALTERNATIVE Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **ALTERNATIVELY, Claims 1, 2, 4-8, 10, 12, 13, 15, 16, 19-23, 25-30, and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (U.S. Patent No. 5,971,855) in view of Dureau (U.S. Patent No. 6,513,160).**

Regarding claims 1, 2, 7, 13, 15, 19, 25-29, and 35-40, Ng teaches a virtual character that conveys desire information through health points (Column 5, Lines 53-55) and the desire information may be satisfied by the user giving the virtual character what it wants (Column 7, Lines 35-38). One of the options is to feed the virtual character (Column 6, Lines 37-39). Ng also teaches connecting the virtual character to a computer and then to a website (Column 2, Lines 38-41), and downloading upgrades as well as restoring, growing, and changing the character's health (Column 3, Lines 59-63, and Column 4, Lines 1-3). Desire information is outputted to the web server when a request is made to restore the character's health. Ng does not specify that the character is nourished by product and advertising information. Dureau teaches a virtual character that is nourished and grows based on being fed commercial advertisements (Column 6, Lines 60-62 and Column 3, Lines 55-58). It would have been obvious to

one having ordinary skill in the art at the time the invention was made to replenish the health of Ng's virtual character with name brand nourishment, as taught by Dureau. This would provide a more realistic approach to feeding the character while providing a greater number of click-throughs for advertiser banners. The web server of Ng stores scores of users' virtual characters (Column 2, Lines 47-51), and this reads on storing the respective effect on the adaptive toy.

Regarding claims 4 and 20, neither Ng nor Dureau teach the updating of advertisement databases. It would have been obvious to one having ordinary skill in the art at the time the invention was made that advertisements would need to be updated continuously. This would give more advertisers a chance to advertise.

Regarding claim 5 and 10, Ng teaches the virtual character as outputting desire information (Column 5, Lines 53-55) and being healed by information downloaded from the web server (Column 4, Lines 1-3). Once the virtual character is connected to a computer through a cable(Column 2, Lines 38-41), a keyboard as an input device becomes inherent in the system. Ng does not specify that the character is nourished by product and advertising information. Dureau teaches a virtual character that is nourished and grows based on being fed commercial advertisements (Column 6, Lines 60-62 and Column 3, Lines 55-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replenish the health of Ng's virtual character with name brand nourishment, as taught by Dureau. This would provide a more realistic approach to feeding the character while providing a greater number of click-throughs for advertiser banners.

Regarding claims 6, 8, 16, and 30, Ng teaches the virtual character as outputting sound effects for eating (Column 6, Lines 20-22).

Regarding claim 12, Ng teaches the web server as storing a character's name (user name) and a character's score (information about the toy) (Column 2, Lines 47-51).

Regarding claims 21-23, these claims introduce the specific data content of the advertising banner database, it could be argued that neither Ng nor Dureau does not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see In re Gulack, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of advertising data content. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

10. **ALTERNATIVELY, Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (U.S. Patent No. 5,971,855) in view of Dureau (U.S. Patent No. 6,513,160), and further in view of Tanaka (U.S. Patent No. 6,120,379).**

Regarding claim 11, Neither Ng nor Dureau teaches a barcode reader or CCD camera as being attached to the toy. Tanaka teaches a toy comprising a CCD camera (Figures 1 and Column 8, Line 26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach a camera to the toy. This would provide more enjoyment for the user. The claim language "for receiving names or barcodes of goods directly by the user" is intended use. The structure recited in claim 11 merely calls for a CCD camera or a barcode reader to be attached to the adaptive toy.

Allowable Subject Matter

11. Claim 18 appears to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

One of the objectionable drawing figures was not fixed or addressed in the filed amendment. The objection is repeated above.

New art has been found and applied in the rejections above, so all arguments are moot.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEFFREY D. CARLSON
PRIMARY EXAMINER

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